

Remarks

Summary of the Office Action

Claims 1-6, 8-11, 13-46, 50-56, 58, 60-85, 87-90, 92-125, 129-135, 137, 139-164, 166-169, 171-204, 208-214, 216, and 218-237 were pending in the application.

Claims 1-7, 9-11, 13-58, 60-86, 88-90, 92-121, 124-136, 139-165, 167-169, 171-179, 182-215, and 218-237 are rejected under 35 U.S.C. §103(a) as being obvious over Hendricks et al. U.S. Patent No. 5,798,785 (hereinafter "Hendricks '785") in view of Maissel et al. U.S. Patent No. 6,637,029.

Claims 8, 58, 87, 137, 166, and 216 are rejected under 35 U.S.C. §103(a) as being obvious over Hendricks '785 in view of Maissel further in view of Hendricks et al. U.S. Patent No. 6,539,548 (hereinafter "Hendricks '548").

Summary Applicants' Reply

Applicants have amended claims 1, 9, 20, 21, 25, 29, 41, 42, 46, 51, 66, 67, 71-76, 80, 88, 99, 100, 104, 108, 120, 121, 125, 130, 145, 146, 150-155, 159, 167, 178, 179, 183, 187, 199, 200, 204, 209, 224, 225, and 229-234 to more particularly define the invention. No new matter has been added and the amendments are fully supported by the specification.

Reconsideration of this application in light of the following remarks is hereby respectfully requested.

Applicants' Reply to the Prior Art Rejections

Claims 1-7, 9-11, 13-58, 60-86, 88-90, 92-121, 124-136, 139-165, 167-169, 171-179, 182-215, and 218-237 are rejected under 35 U.S.C. §103(a) as being obvious over Hendricks '785 in view of Maissel.

Claims 8, 58, 87, 137, 166, and 216 are rejected under 35 U.S.C. §103(a) as being obvious over Hendricks '785 in view of Maissel further in view of Hendricks '548.

These rejections are respectfully traversed.

I. THE CITED REFERENCES DO NOT SHOW OR SUGGEST ALL OF THE ELEMENTS OF APPLICANTS' CLAIMS

Applicants amended independent claims 1, 29, 51, 80, 108, 130, 159, 187, and 209 (and their dependent claims) are, generally speaking, directed towards methods and systems for providing audience size information to a user within an interactive television application. The independent claims specify, amongst other things, that the audience size information provided for a particular program may be i) updated based on receiving indications of playbacks of recorded programs from a plurality of audience members (claims 1, 80, and 159), ii) calculated based on a graded approach of assigning a predetermined quantity of points to each of a plurality of actions performed by a plurality of audience members (claims 29, 108, and 187), or iii) updated based on receiving indications of a plurality of audience members performing actions related to an upcoming program (claims 51, 130, and 209).

Hendricks '785 refers to a television program delivery system that provides a user with a list of suggested programs based on several factors including

the user's viewing choices. The system attempts to learn the user's viewing choices and suggests programs that the subscriber is likely to watch. However, Hendricks '785 does not show or suggest all of the elements of applicants' amended independent claims 1, 29, 51, 80, 108, 130, 159, 187, and 209.

In particular, at page 3, lines 12-14 of the Office Action, the Examiner admits that Hendricks '785 does not show or suggest i) updating or calculating audience size information based on the actions of a plurality of audience members and ii) providing the user with audience size information within an interactive television application. Instead, Hendricks '785 only refers to providing programming suggestions to a user based on the programs watched by that user.

In fact, Hendricks '785 actually teaches away from these aspects of applicants' claimed invention. Hendricks '785 provides a television system capable of "choosing a programs that the subscriber is likely to watch." Hendricks '785, column 3, line 1. This selection is made based on the subscriber's "mood, personal profile, and historical program watched and network watched data." Id., lines 2-4. The system of Hendricks '785 suggests programming to users based on the user's own preferences and interests and thus teaches away from applicants' independent claims which provide audience size information that is based on the actions of other users'.

In an attempt to remedy at least some of these deficiencies in Hendricks '785, the Examiner has attempted to combine Hendricks '785 with Maissel.

The Examiner argues that Maissel shows "collecting viewing data from a multiplicity of viewers of a television system, computing audience information from the collected viewing data, and transmitting the computed audience information to a viewer of the television system." (Maissel, column 8, lines 33-36)

However both Hendricks '785 and Maissel both fail to show or suggest i) "updating audience size information for [a] recorded program in response to receiving [playback] indications from a plurality of audience members," ii) "calculating audience size information for a program . . . based on a graded approach of assigning a predetermined quantity of points to each of a plurality of actions performed by a plurality of audience members," and iii) "updating audience size information for [an] upcoming program in response to receiving [indications from a plurality of audience members performing actions related to the upcoming program]," as respectively required by applicants' amended independent claims 1, 29, 51, 80, 108, 130, 159, 187, and 209.

Thus, whether taken alone or in combination, applicants respectfully submit that Hendricks '785 and Maissel do not show or suggest all of the elements of applicants' amended independent claims.

II. THE EXAMINER HAS FAILED TO PROVIDE MOTIVATION TO COMBINE THE REFERENCES

In order to establish a *prima facie* case of obviousness based on a combination of references, there must be "some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally

available to one of ordinary skill in the art." MPEP, at § 2143.01. Applicants respectfully submit that the Examiner has failed to fulfill the requirement of presenting an "objective teaching . . . or . . . knowledge generally available to one of ordinary skill in the art that would lead that individual to combine the relevant teachings of the references," In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). See In re Rouffet, 149 F.3d 1350, 1355 ("When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references"). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'" of a motivation to combine. In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999), abrogated on other grounds by In re Gartside, 53 USPQ2d 1769 (Fed. Cir. 2000).

In support of the combination of Hendricks '785 with Maissel, the Examiner states that it would have been obvious to combine these references "to provide the user updated audience information in response to receiving and [sic] indication to enable the user to quickly make a decision on the recorded programs accordingly." Office Action, pages 3-4.

Applicants respectfully submit that this is not sufficient motivation to combine Hendricks '785 and Maissel. In particular, both of these references refer to two completely different techniques for assisting users to select television programs. In Hendricks '785 television programs are recommended based on determining the user's preferences while Maissel lets the users know what other people are presently watching. Moreover, neither of these references show

or suggest updating audience size information based on receiving indications of the playback of recorded programs, as specified in applicants' independent claims 1, 80, and 159. Accordingly, the Examiner has not provided sufficient motivation to combine Hendricks '785 with Maissel.

Additionally, the Examiner has only attempted to provide motivation to combine Hendricks '785 with Maissel to show the elements of applicants' independent claims 1, 80, and 159, which specify that audience size information is updated in response to receiving indications of playbacks of recorded programs from a plurality of audience members. However, the Examiner has not provided a motivation to combine Hendricks '785 with Maissel that relates to the features of applicants' other independent claims (i.e., claims 29, 51, 108, 130, 187, and 209). Therefore, because each element of the prima facie case of obviousness has not been met (i.e., no motivation has been provided), the rejection of at least claims 29, 51, 108, 130, 187, and 209 should be withdrawn.

Further, the Examiner has merely listed an alleged benefit of applicants' novel invention as motivation to combine the references instead of pointing to an objective teaching in either Hendricks '785 or Maissel that would lead one of ordinary skill in the art to combine these references. Namely, the Examiner has indicated that there is a benefit to providing audience information for recorded programs to help users in choosing recorded programming, but not why one of ordinary skill in the art would be motivated to combine the systems Hendricks '785 and Maissel to achieve this result.

These two system cannot be combined in this manner without an objective teaching in either Hendricks '785 or Maissel that would lead one of ordinary skill in the art to combine these references. Accordingly, the Examiner has not provided sufficient motivation to combine Hendricks '785 and Maissel.

III. THE EXAMINER HAS EMPLOYED HINDSIGHT
RECONSTRUCTION IN COMBINING THE REFERENCES

Applicants respectfully submit that the Examiner has employed hindsight reconstruction in combining the references. With the knowledge of applicants' novel system for providing audience size information to a user within an interactive television application, particular features of the prior art were identified for use in rejecting applicants' invention. This technique has long been held invalid by the courts at creating a *prima facie* case of obviousness. See In re Fine, 5 USPQ2d at 1600. ("One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.").

The Examiner has used applicants' own invention as a bridge between Hendricks '785 and Maissel. In doing so, the Examiner has demonstrated mere hindsight reconstruction, the very "syndrome" that the requirement for objective evidence is designed to combat, and the rejection is therefore insufficient as a matter of law. See In re Dembiczak, 50 USPQ2d at 1617-1618.

IV. CONCLUSION

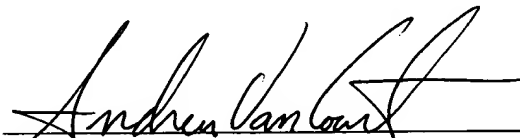
For at least the forgoing reasons, applicants respectfully request that the rejection of amended independent claims 1, 29, 51, 80, 108, 130, 159, 187, and 209 be withdrawn.

The remaining dependent claims all variously depend from amended independent claims 1, 29, 51, 80, 108, 130, 159, 187, and 209 that are non-obvious over the prior art. Accordingly, applicants respectfully request that the rejection of these claims should also be withdrawn.

For at least the reasons set forth above, applicants respectfully submit that claims 1-6, 8-11, 13-46, 50-56, 58, 60-85, 87-90, 92-125, 129-135, 137, 139-164, 166-169, 171-204, 208-214, 216, and 218-237 are in condition for allowance.

Reconsideration and prompt allowance of this application are respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Andrew Van Court", is written over a horizontal line.

Andrew Van Court
Registration No. 48,506
Agent for Applicants
Fish & Neave IP Group
Ropes & Gray LLP
Customer No. 1473
1251 Avenue of the Americas
New York, New York 10020
Tel.: (212) 596-9000
Fax: (212) 596-9090